

Remarks

A. *Status of Application*

Claims 1-61 were pending. Claims 10-18, 23-25, 27, 29, 48-52, and 54 have been canceled without prejudice. Claims 1-9, 19-22, 26, 28, 30-47, 53, and 55-61 will be pending upon entry of this paper.

B. *Section 103 Rejections*

Claims 1 through 55 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,706,441 to Lockwood in view of U.S. Patent No. 6,195,612 to Pack-Harris. These rejections have been maintained from the previous Office Action. Applicant respectfully traverses the rejections.

Claim 1 of the present application involves, in part, a quality tool that includes “a measure indicating the **frequency with which a level of dosing of medication was prescribed** by an entity in the pluralities of entities,” and that tool is used “to select one entity for providing health care services to a health care consumer.” Other independent claims include equally compelling or similar concepts. For example:

- Independent claim 19 involves the frequency with which appropriate diagnostic testing was performed when prescribing antibiotics;
- Independent claim 26 involves a safe dosing of a medication measure (among other novel/nonobvious measures);
- Independent claim 28 involves a safe dosing measure;
- Independent claim 30 involves an overuse of antibiotics measure;
- Independent claim 31 involves a safe dosing measure;
- Independent claim 32 involves deriving a measure indicating the frequency with which a dosing of a medication was prescribed;
- Independent claim 53 involves a safe dosing measure;
- Independent claim 55 involves an overuse of antibiotics measure; and
- Independent claim 56 involves a score indicating a frequency and dose level for each measure.

The Examiner admits that Lockwood does not teach the measures indicating medication prescribing practices of each health-care provider of the listing and the score indicating a

frequency and dose level for each measure in the plurality of measures. See Office Action, page 3. Applicant appreciates this candor because it simplifies issues in this case.

Pack-Harris also fails to teach the features that are admittedly absent from Lockwood. For at least this reason, the present application is allowable.

The Examiner asserts that Pack-Harris teaches frequency/dose-level concepts because of Pack-Harris' mention of "prescription utilization information." See Office Action, page 3. As support for this specific teaching, the Examiner cites only to column 2, lines 39-45 of Pack-Harris. Those lines are insufficient as a matter of law to rise to a proper obviousness rejection because, at a minimum, they fail to disclose or suggest the features currently being claimed, including those discussed and bulleted above.

The cited Pack-Harris passage states:

Briefly, the above and further objects of the present
 40 invention are realized by providing a new and improved
 pharmacy benefit management system which enables a
 medical group to monitor prescription utilization informa-
tion for the medical group to enable the medical group to
manage pharmacy costs relative to a pharmacy benefit
 45 capitation.

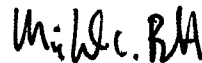
(emphasis added). Applicant respectfully submits that this passage does not disclose, teach, or suggest, e.g., the features cited above. For example, this passage is silent as to frequency with which a particular level of dosing of medication was prescribed, a frequency of diagnostic testing when prescribing antibiotics, a safe dosing measure, or an overuse of antibiotics measure. Additionally, Applicant has done a word search within Pack-Harris for "dose," "dosage," "dosing," "frequency," and "level" with no results. If the Examiner is of the opinion that some other portion of Pack-Harris renders any claims unpatentable with respect to any prescription related data, it should have been cited or discussed to give the Applicant a chance to respond. Based on the Examiner's citation, however, Pack-Harris appears to simply involve monitoring some generic "prescription utilization information" for the purpose of managing costs relative to a pharmacy benefit. See passage above. Applicant believes that such a disclosure is clearly and patentably distinct from the very focused, specific measures being claimed here and asks for favorable reconsideration of the present application.

It appears that the Examiner is taking the position that Applicant's "wherein" clauses should be given some lesser effect in the claims since the Examiner argues they are not an "active step." See, e.g., Office Action, page 5. It is not clear whether this point affected the present rejections, but Applicant points out that the "wherein" clauses are included in the body of the claims and constitute elements just like the other claim elements and should therefore be given full effect. The Examiner has pointed to no caselaw, and Applicant is aware of none, that would lead one to ignore the "wherein" clauses or treat them differently.

Applicant points out that claims 10-18, 23-25, 27, 29, 48-52, and 54 have been canceled not in response to past or present rejections but, instead, to streamline issues presented in this paper and to better focus arguments. Applicant does not acquiesce with respect to any past arguments not repeated here.

Applicant believes that these remarks fully respond to all outstanding matters for this application. Applicant respectfully requests that the rejections of all claims be withdrawn. Should the Examiner desire to sustain any rejections, the courtesy of a telephone conference between the Examiner, the Examiner's supervisor, and the undersigned attorney is respectfully requested in advance.

Respectfully submitted,



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